

REMARKS

I. Introduction

Claims 1 to 20 are currently pending in this application. Claims 11 to 18 have been withdrawn from consideration. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the receipt of all certified copies of the priority documents.

II. Objection to the Drawings

The drawings were objected to as allegedly failing to comply with 37 C.F.R. 1.84 (p) (4). The Office Action alleges that reference numbers "4" and "9" are both used to designate the fluid pockets of Figures 1 and 3. Applicant submits that reference number 4 represents the working space in general and reference number "9" represents the variable volume kidney shaped fluid pocket extending axially and asymmetrically inside working space 4. See Specification at p. 7, lines 15 to 19. Therefore, neither reference number "4" nor "9" is redundant. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

III. Objection to Claim 1

The Office Action objected to the recitation of "can have" in claim 1. Claim 1 has been amended to incorporate the Office Action's suggestions. Applicant submits that claim 1, as amended, overcomes the objection to claim 1. Accordingly, withdrawal of this objection is therefore respectfully requested.

IV. Rejection of Claims 1 to 10, 19 and 20 Under 35 U.S.C. § 102 (b)

Claims 1 to 10, 19 and 20 were rejected under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 5,386,973 ("Brenner et al."). Applicant respectfully submits that Brenner et al. do not anticipate claims 1 to 10, 19 and 20 for the following reasons.

Claim 1 relates to a hydraulic bearing. Claim 1 recites that the hydraulic bearing includes a journal bearing and a supporting bearing which are

joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space. Claim 1 further recites that the working space and the compensating space are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing (1) and the supporting bearing (2) with respect to one another, the damping device (6) has damping fluid flowing through it.

Brenner et al. purportedly relate to an elastomeric bearing. Abstract. Brenner et al. state that the bearing includes at least two fastening parts 7 and 8 connected to one another by means of an elastomer spring 6. Inside the elastomeric bearing at least two damping devices are stated to work essentially independent of one another. See col. 4, lines 4 to 12. The first independent damping device is stated to include chambers 3a and 3b, which are stated to communicate via passage 4. The second independent damping device is stated to include chambers 1a and 1b, which are stated to be separated by partition 10 having passage 2. The first independent damping device is stated to dampen in the radial direction and the second independent damping device is stated to dampen in the longitudinal direction. See col. 4, lines 17 to 40. Accordingly, fluid only flows through partition 10 (damping device) in the second damping device when parts 7 or 8 are excited in a longitudinal direction. Brenner et al. do not disclose, or even suggest, that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Therefore, Brenner et al. do not disclose all of the limitations of claim 1.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Brenner et al. do not disclose, or even suggest, a working space and a compensating space that are each filled with a damping fluid and communicate

through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Therefore, it is respectfully submitted that Brenner et al. do not anticipate claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claim 1 is respectfully requested.

As for claims 2 to 10, 19 and 20 which ultimately depend on claim 1 and therefore include all of the limitations of claim 1, Applicant respectfully submits that these claims are patentable for at least the same reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 2 to 10, 19 and 20 is respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.


Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached pages are captioned "**Version with Markings to Show Changes Made.**"

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 1 has been amended as follows:

1. (Amended) A hydraulic bearing, comprising: a journal bearing and a supporting bearing which are joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space, the working space and the compensating space being each filled with a damping fluid and communicating through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing (1) and the supporting bearing (2) with respect to one another, the damping device (6) [can have] has damping fluid flowing through it.